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C. & M.
12/09/97

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

LEE

FWC of Appln. No. 08/583,491

Group Art Unit: 1818

Filed: November 7, 1997

Examiner: M. Allen

FOR: GDF-1

* * *

November 7, 1997

REQUEST FOR SUSPENSION OF ACTION

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Sir:

In accordance with the provisions of 37 C.F.R. 1.103(a), request by way of petition is hereby made to suspend action on the above-referenced application by the U.S. Patent and Trademark Office for a period of six months, up to and including May 7, 1998, based on the following showing of good and sufficient reasons.

A file wrapper continuing (FWC) application under 37 C.F.R. 1.62 is being filed together with this petition. Therefore, no response by applicant to an Office Action is required.

In the Office Action of May 7, 1997, the Examiner has maintained her rejection of the claims under 35 U.S.C. 112, first paragraph. The Examiner's position appears to be that the specification's disclosure of how the claimed invention is to be used is not credible in the absence of declaration

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evidence supporting those uses. Although this position is disputed, such evidence is currently being obtained in the interest of furthering prosecution in this application.

The Examiner has withdrawn the portion of the enablement rejection with respect to making the claimed invention. The Examiner admits that the specification would enable the recombinant production of GDF-1 using conventional techniques and the sequence disclosed by the present application.

In view of time required to produce GDF-1, establish an assay which would support use of GDF-1 as disclosed in the specification, collect data from the assay, and prepare a declaration based on the data, applicant requests suspension of action so that the necessary data may be presented to the Examiner prior to a first Office Action on the merits. Like the recombinant production of GDF-1, assays which would establish the biological activity of GDF-1 are known in the art. Applicant submits that such declaration evidence will allow the Examiner to withdraw the enablement rejection and allow the pending claims.

Thus, it is the intent of the undersigned to place the present application in the best posture for further consideration by the Examiner.

The fee as required by 37 C.F.R. 1.17(i) is enclosed herewith. If this fee is missing or insufficient, the Office is hereby authorized to charge our Deposit Account No. 03-

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3975, Order No. 20263/220232 for the missing or insufficient amount, for which purpose a duplicate copy of this paper is attached.

Prompt consideration of this petition and a favorable response are earnestly requested. The Office is invited to contact the undersigned if further information is needed.

Respectfully submitted,

Cushman Darby & Cushman
Intellectual Property Group of
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By

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